Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILTON T. CATOE
and GARLAND R. WENTRCEK

Appeal No. 2002-1633
Application 09/281,093

ON BRIEF

Before ABRAMS, STAAB, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Wilton T. Catoe et al. appeal from the final rejection of claims 1 through 19, all of the claims pending in the application.

THE INVENTION

The invention relates to "an apparatus for automatically collating sample laminate chips used at [kitchen/bathroom] design centers for the selection of proper [countertop] laminates"

(specification, page 1). Representative claim 1 reads as follows:

1. A collating apparatus for collecting sample chips, comprising:
a framework supporting a plurality of supply bins housing sample chips and a track running adjacent the plurality of supply bins;
at least one collection bin shaped and dimensioned for movement on the track; and
at least one gantry for transferring sample chips from the plurality of supply bins to the at least one collection bin when the at least one collection bin is aligned with respective supply bins.

THE REJECTIONS

Claims 1, 2, 5, 6, 8, 9, 14, 16 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,824,306 to Stevenson.

Claims 3, 4, 7, 10 through 13, 15, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevenson.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 15 and 17) and to the examiner's final rejection and answer (Paper Nos. 8 and 16) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 1, 2, 5, 6, 8, 9, 14, 16 and 17

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Stevenson discloses "an automatic stacking apparatus which can collate and stack laminate plastic sample chips for forming into loops for use by customers in the selection of laminate plastic sheets for purchase" (column 1, line 66, through column 2, line 3). The apparatus 2 includes a supporting platform 24, a plurality (e.g., twelve) of reservoirs 6 each filled with a stack of chips 4 of a particular color, pattern or composition, receivers 8 movable past the reservoirs over a series of

descending steps 20 each lower than its predecessor by a height at least equal to the thickness of a chip, injectors 30, 31 for transferring the chips from the reservoirs to the receivers to form sample stacks of chips, a staging area 26 upstream of the first reservoir, and a holding area 28 downstream of the last reservoir. The injectors comprise planar tines 16 movable by means of cylinder-piston units 11, 12, into the bottoms of the reservoirs to engage and push the lowermost chip in each into a waiting receiver. Subsequent to priming receivers which have been pre-positioned on the steps adjacent respective reservoirs (see column 4, lines 34 through 62),

> [t]he apparatus is activated by the first pump of air [to the cylinder/piston units], causing one chip per receiver to be ejecting simultaneously into the twelve receivers 81, 82, 83 . . . 84. FIG. 5 illustrates the status of the receivers immediately following this first stroke. At this point, an empty receiver 80 is introduced from staging area 26 of platform 24 by pushing it, either manually or through automatic operation, against receiver 81. This forces receiver 81 to drop down a step 20 on ramp 86 into position opposite reservoir 62, receiver 82 to drop opposite reservoir 63 and so on. Receiver 84, now full, is forced onto the holding area 28, from where it may be removed for assembly elsewhere into a chip sample loop. The stack 5 of chips thus collated in final receiver 84 is removed, a ball link chain inserted in the aligned apertures 3 of the chip stack and the ends of the chain linked together in the manner known in the art (not illustrated) [column 4, line 63, through column 5, line 11].

The appellants (see pages 8 through 10 in the main brief) submit that the anticipation rejection of independent claim 1 is unsound because Stevenson does not disclose a collating apparatus meeting the limitations in the claim pertaining to the "track." The examiner (see pages 6 and 7 in the answer), citing a definition of the term "track" as meaning "a path along which something moves; a course" (answer, page 6),[1] contends that these limitations find full response in Stevenson's steps 20.

During patent examination claims are to be given their broadest reasonable interpretation consistent with the underlying specification without reading limitations from the specification into the claims. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The definition of "track" advanced by the examiner is fully consistent with both the ordinary and accustomed meaning of this term[2] and the manner in which it is used the appellants' specification, and is accurately descriptive of Stevenson's steps 20 which form a path or course along which

[1] The examiner's source for this definition is The American Heritage Dictionary of the English Language, Third Edition (1992).

[2] For example, Webster's New World Dictionary of the American Language, Second College Edition (The World Publishing Co. 1970) similarly defines "track" as meaning "a course or line of motion or action; route; way."

the chip receivers 8 move. Hence, the examiner's determination that Stevenson's steps 20 meet the "track" limitations in claim 1 is well taken, while the appellants' argument to the contrary, which is predicated on an improper reading of limitations from the specification into the claim, is not.

We shall therefore sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Stevenson.

We also shall sustain the standing 35 U.S.C. § 102(b) of dependent claims 2 and 5 as being anticipated by Stevenson since the appellants, stating that these claims stand or fall together with parent claim 1 (see page 7 in the main brief), have not separately challenged the merits thereof.

Claims 6 and 14, which respectively depend from claims 2 and 1, further define the claimed collating apparatus as having at least one "pick up arm" which selectively retrieves sample chips from the supply bins and places them within the at least one collection bin. Claims 8 and 9 depend from claim 6, and claims 16 and 17 depend from claim 14. According to the examiner (see pages 7 and 8 in the answer), Stevenson's arms (presumably tines 16) constitute pick up arms because they "pick up" chips 4 from the supply bins (reservoirs 6) and place them into the collection bins (receivers 8). The examiner, however, has failed to proffer

any recognized definition of the term "pick up," or a convincing line of reasoning, which supports this proposition.

Therefore, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 6, 8, 9, 14, 16 and 17.

II. The 35 U.S.C. § 103(a) rejection of claims 3, 4, 7, 10 through 13, 15, 18 and 19

We shall sustain the standing 35 U.S.C. § 103(a) of dependent claims 3 and 4 as being unpatentable over Stevenson since the appellants, stating that these claims stand or fall together with parent claim 1 (see page 7 in the main brief), have not separately challenged the merits thereof.

Claims 7 and 15, which respectively depend from claims 6 and 14, further define the pick up arm recited in these parent claims as a "vacuum arm employing vacuum pressure to retrieve the sample chips." Conceding that Stevenson does not respond to these limitations, the examiner (see pages 3 and 4 in the final rejection and pages 8 through 11 in the answer) takes official notice that vacuum end effectors are well known in the art and concludes that it would have been obvious to substitute same into the Stevenson apparatus, presumably in place of the pushing tines 16, "in order to be able to lift the sample chips, so as to avoid the need for a continuous, smooth surface between the supply bins

and the collection bins" (final rejection, page 4). Even if the examiner's taking of official notice in this regard has been properly substantiated (the appellants contend that it has not), there is nothing in the mere conventional knowledge of vacuum end effectors which would have suggested the substantial modification of the Stevenson apparatus contemplated by the examiner.

Claims 10 and 18, which respectively depend from claims 2 and 1, require the supply bins recited in these parent claims to be "positioned in rows of at least two supply bins." Claims 11 through 13 depend from claim 10 and claim 19 depends from claim 18. Acknowledging Stevenson's lack of response to these limitations, the examiner nonetheless concludes that it would have been obvious modify the Stevenson apparatus to include such an arrangement "since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art" (final rejection, page 4). As correctly pointed out by the appellants (see pages 18 through 21 in the main brief), however, this proposed modification would involve far more than a mere duplication of parts. In short, the examiner has failed to provide the factual support necessary to conclude that the subject matter in question would have been obvious.

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 7, 10 through 13, 15, 18 and 19 as being unpatentable over Stevenson.

SUMMARY

The decision of the examiner to reject claims 1 through 19 is affirmed with respect to claims 1 through 5 and reversed with respect to claims 6 through 19.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS Administrative Patent Judge	)	
	)	BOARD OF PATENT
	)	APPEALS AND
LAWRENCE J. STAAB Administrative Patent Judge	)	INTERFERENCES
JOHN P. MCQUADE Administrative Patent Judge	)	

JPM/kis

WILSONART INTERNATIONAL INC.
C/O WELSH & FLAXMAN, LLC
2341 JEFFERSON DAVIS HIGHWAY
SUITE 112
ARLINGTON, VA 22202